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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,861	12/12/2001	Neil S. Cutshall	240083.514	2603

500 7590 07/22/2003

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EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/22/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

10/015,861

Applicant(s)

CUTSHALL ET AL.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,13-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,13-16 and 18-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims pending 1, 4-11,13-16,18-30.

Claims 2,3, 12, 17, 31-44 have been cancelled.

The rejection of claims 16,18-29 on 112 2<sup>nd</sup> still stands.

Claim 29 indicates R4 is hydrogen and claim 1 has no antecedent basis of it being hydrogen!!

The rejection of claims 1, 2, 4 under 35 USC 102 b over Mirek Julian has been withdrawn since applicants have amended the proviso in the claims.

The rejection of claims 1, 5,6, 8 over 35 USC 112 first, however still stands.

The specification does not teach any compounds with R4 substituents. Besides with n=3 and R4 being heterocyclic aliphatic ring, with all the other positions already substituted would require more than ordinary skill in the art to make and use.

The examples provided do not have any guidance of compounds with any R4 other than it being H.

New ground(s) of rejection made in response to applicants amendments.

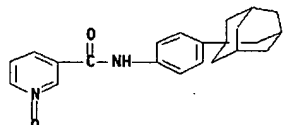
#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Danilenko, G. I.  
Antiinflammatory action .... English abstract DN 89:89560. 1976.

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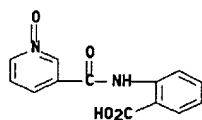
The reference discloses



Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by

English abstract DN 87:5812, SU 539878, **Preparation and antiphlogistic activity of carboxyphenylamides of nicotinic or isonicotinic acid**. U.S.S.R. From: Otkrytiya, Izobret., Prom. Obraztsy, Tovarnye Znaki 1976, 53(47), 76.

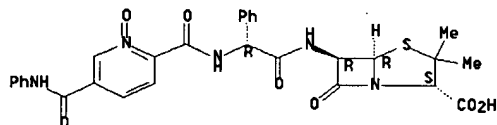
The reference discloses



which reads on R3 being a substituted aryl R1 is R5 is hydrogen, n is o.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by English Abstract DN 97:215892 Penicillin derivs. and their salts JP 57109792 1982.

The reference discloses



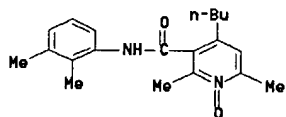
wherein the R5 is a hetero group .

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 63017811

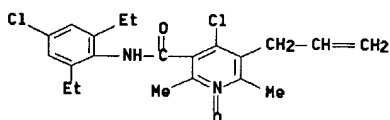
Yagihara, Hiromu. English Abstract DN 109:68852

The reference discloses



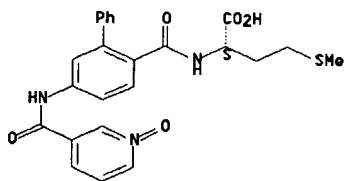
This reads on the compounds when n is 2, R1 is R5 is an alkyl, and R3 is a substituted phenyl.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ca plus English abstract 110:154162 EP 292990. Yagihara, Hiroshi et al



Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by English abstract DN 127:51002. WO 9717070, Sebt Said et al.

The reference discloses

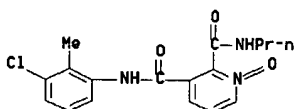


The R1 is R5 is hydrogen and the R3 is a substituted phenyl.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus English abstract DN 127:331402, Preparation of pyridine-2,3-dicarboxamides., Tonishi, Masanori et al .EP 799825 A1

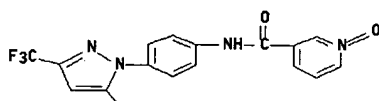
The reference discloses



which reads on the compounds wherein R1 is a hetero-alkylene-R5 .

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus English abstract DN 132:22963, Preparation of N-(pyrazolylphenyl)alkanamides and analogs as IL-2 production inhibitors, Betageri, Rajashekhar et al , WO 9962885 .

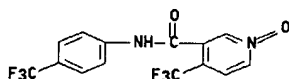
The reference discloses



which reads on the R3 aryl substituted by a heterocyclic group.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by English Abstract DN 133:135326, Preparation of amide .....,Miyahara, Osamu et , JP 2000226372

The reference discloses



which reads on the compounds wherein the R4 is an alkyl substituted and also the R3 is a phenyl substituted and R1 is R5 is a hydrogen.

***Conclusion***

The claims are hence not allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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A handwritten signature in black ink, appearing to read "R. Desai", with a long, sweeping underline.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

R.D.  
July 18, 2003